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September 13, 2004

Mail Stop Appeal Brief - Patent

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Re: U.S. Patent Application No. 09/696,664
Filed: October 25, 2000
Title: **Nucleic Acid Molecules and Other Molecules
Associated with Plants**
Applicants: Mark S. ABAD *et al.*
Atty. Docket: 16517.316

Sir:

The following documents are forwarded herewith for appropriate action by the U.S. Patent and Trademark Office (PTO):

1. Appellant's Reply Brief; and
2. a return postcard.

Please stamp the attached postcard with the filing date of these documents and return it to our courier.

In the event that extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned. Applicants do not believe any fees are due in conjunction with this filing. However, if any fees are required in the present application, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter LLP Deposit Account No. 50-2387, referencing matter number 16517.316. A duplicate copy of this letter is enclosed.

Respectfully submitted,

Thomas E. Holsten (Reg. No. 46,098)
Holly Logue Prutz (Reg. No. 47,755)
David R. Marsh (Reg. No. 41,408)

Attachments



AF/1631
IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Mark S. ABAD *et al.*

Appln. No.: 09/696,664

Filed: October 25, 2000

For: **Nucleic Acid Molecules and Other
Molecules Associated with Plants**

Art Unit: 1631

Examiner: Michael L. BORIN

Atty. Docket: 16517.316

Confirmation No. 5102

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief – Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This is a reply to a new point of argument raised in the Examiner's Answer mailed July 12, 2004 ("Examiner's Answer").

1. The Examiner's New Points of Argument

a. The Rejection Raised Under 35 U.S.C. § 112, Second Paragraph

Under Heading Number 11, "Response to Argument", The Examiner's Answer alleges that Appellant's Brief filed April 13, 2004 "provides arguments only to the first 'written description' rejection." Examiner's Answer at page 21. Appellant respectfully disagrees. However, Appellant agrees with the Examiner that the asserted written description rejections of record are based on two grounds. His first ground is based on the "comprising" language and the second is premised on the percent identity language of claims 10-13. The Examiner has erred in ignoring statements and in mischaracterizing arguments made in the Appellant's Brief and alleges that Appellant provided arguments to only the first ground of rejection under 35 U.S.C § 112, first paragraph. The

Appellant's Brief, for example, sets forth arguments relating to the disclosure of variations including and directed to the claimed nucleic acid molecules and specifically points to hybridization conditions and site-directed mutagenesis disclosed in the specification. Moreover, Appellant reiterates that the structural features of the nucleotide sequences of SEQ ID NO:3 have been disclosed. This argument applies with equal force to both grounds for the Examiner's written description rejection. The respective structural feature (for example, the nucleotide sequences of SEQ ID NO:3 and variations thereof) is shared by every nucleic acid molecule in the claimed genera, and it distinguishes the members of the claimed genera from non-members. In addition, footnote 11 states that "[t]his argument applies with equal force to every genus of the claimed nucleic acid molecule. For example, if a nucleic acid molecule such as an mRNA, comprises a nucleotide sequence having 95% identity to SEQ ID NO: 3, then it is a member of the genus of nucleic acid molecules having 95% identity to SEQ ID NO: 3. *See*, claim 11." As such, the Examiner's assertion that Appellant has provided arguments only for the first ground is not proper.

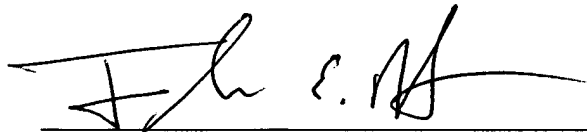
Moreover, the Appellant has pointed out portions of the specification that disclose nucleic acid sequences having the recited sequence identity with SEQ ID NO: 3. *See*, Appellant's Brief filed April 3, 2004 at page 2, under heading 5 "Summary of the Invention." Appellant wishes only to clarify the record on this point and present a correct assessment of the arguments presented in the Appellant's Brief filed April 3, 2004.

Accordingly, claims 1, 8 and 10-13 are supported by an adequate written description, and the rejection should be reversed.

CONCLUSION

In view of the foregoing, it is respectfully requested that the Board of Patent Appeals and Interferences reverse the Rejections and that the subject application be allowed forthwith.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. E. Holsten', written over a horizontal line.

Date: September 13, 2004

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